

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

PRAMIL S.R.L. (ESAPHARMA),

Petitioner,

vs.

MICHEL FARAH,

Registrant.

Cancellation No. 92032341

REPLY TO REGISTRANT'S MOTION TO SUSPEND PROCEEDING

Registrant filed by mail on March 16, 2006, a Motion to Suspend Proceeding based upon a civil action in the United States District Court for the Southern District of Florida only three days before, on March 13, 2006.

This is yet another in a very long history of delays and extensions that have been filed by the Registrant in an effort to stall the present proceeding.

This Cancellation began over four and one-half years ago and has been replete with Registrant's extension requests



and Petitions, the most recent having been denied by the Assistant Commissioner.

The case before the Board is complete, absent the Oral Argument which was requested by Petitioner over one year ago. Testimony is complete and the Briefs of the parties have been submitted. Accordingly, there is no pressing need at this time to extend and suspend the matter any further.

The Civil Action has been brought by Gapardis Health and Beauty, Inc., which is not a party to the TTAB proceedings. Further, it is unknown if service of the complaint was ever made of the defendant, Pramil S.R.L. (ESAPHARMA), which is a foreign company. In any event no Answer to the complaint has apparently been filed to date.

Beside the difference in the parties, there is no showing that a result in the civil action will have a bearing on the issues before the Board, merely an allegation that "the litigation will have a bearing upon this proceeding". It is impossible for the Board to ascertain, prior to the filing of an answer in the civil action, whether the final determination of that proceeding will have a bearing on the issues before the Board. TBMP §510.02(a).

Suspension of a Board proceeding pending the final determination of a proceeding in the courts is solely within the discretion of the Board and in this case, it is believed to be inappropriate. The District Court for the Southern District of Florida has a history of long extensive delays and backlogs, resulting in long pendency of civil actions.

A motion to Suspend that is filed after the conclusion of testimony and briefing periods is untimely and has frequently been denied by the Board. See *Ortho Pharmaceutical Corporation v. Hudson Pharmaceutical Corporation*, 178 USPQ 429 (TTAB 1973).

The most strikingly similar case to this was *E.I. du Pont de Nemours and Company v. G.C. Murphy Company* 199 USPQ 807, 808 footnote 3, (TTAB 1978). In that case a Civil Action against the Opposer was filed in the United States District Court for the Northern District of Illinois after the trial periods had expired and the briefs having been filed at the TTAB. A Motion to Suspend the Board proceeding was denied and the Opposition decision was expedited before the civil action got underway.

In view of the comments and case law noted above,
denial of the Motion is solicited.

Respectfully submitted



March 22, 2006

Donald L. Dennison
Attorney for Petitioner
Pramil S.R.L. (ESAPHARMA)
DENNISON, SCHULTZ, DOUGHERTY
& MACDONALD
1727 King Street
Suite 105
Alexandria, VA 22314
(703)837-9600 Ext. 15

CERTIFICATE OF SERVICE

I certify that a copy of the above Reply to
Registrant's Motion to Suspend was served by first class mail
with proper postage affixed this 22nd day of March 2006 to
counsel for Registrant, David M. Rogero, Esq., 2600 Douglas
Road, Suite 60, Coral Gables, FL 33134.



Donald L. Dennison